

Application No.: 09/509,869

Docket No.: 21547-00268-US

**REMARKS**

Claims 1, 2 and 4-10 and 13-16 are pending. Claims 1 and 16 are independent. Claims 11 and 12 have been canceled without prejudice or disclaimer of the subject matter contained therein. Applicants respectfully request reconsideration and withdrawal of the Rejection mailed March 30, 2004, and allowance of the present application.

***Allowable Subject Matter***

Claims 1, 2, 4-10 and 13-16 were indicated as allowable if the rejection under 35 U.S.C. § 112, first paragraph, is overcome.

***Rejection Under 35 U.S.C. § 112, First Paragraph***

Claims 1, 2, and 4-16 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse.

The Examiner states that the recitation of threads having a slight conicity, two sections of differing conicity, and the recitation of bone being forced out upon screwing of the implant in a hole in a bone are not described in the specification.

The purpose of the enablement requirement is to ensure that the invention is communicated to the public so that those of ordinary skill in the art can make and use the claimed invention.<sup>1</sup> "Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention."<sup>2</sup> "A patent need not teach, and preferably omits, what is well known in the art."<sup>3</sup> "[T]he Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention."<sup>4</sup>

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<sup>1</sup> See MPEP 2164.

<sup>2</sup> *Id.*

<sup>3</sup> *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1986).

<sup>4</sup> See *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Application No.: 09/509,869

Docket No.: 21547-00268-US

The present disclosure clearly satisfies the above standards for enablement. Specifically, Figure 1 of the drawings illustrates two conicities 3d, 3e. The use of two conicities is also described in detail with reference to Figure 1, beginning at line 25 of page 11. Beginning at line 25, a threaded implant is described as having two conicities, with a thread 3d having a slight conicity angle  $\alpha$ , and a thread 3e having a greater conicity angle  $\beta$ .

The specification also discusses the use of multiple thread spirals in detail. Beginning at line 13 of page 8 of the specification, a feature of the embodiments is described as choosing the number of thread spirals, which can be two, three or four. Figures 11 and 12 illustrate the multiple thread spirals, which are further described beginning at line 31 of page 13. Further, the present specification describes that the introduction of multiple thread spirals, *per se*, is known. In addition, support for the claimed subject matter can be found in originally filed claims 1-15.

In light of the above specific but not exhaustive list of citations from the specification, the specification provides a full description of multiple conicities and thread spirals as claimed.

The functional recitation of bone being forced out upon screwing of the implant in a hole in a bone is also fully described in the specification. The description is present, for example, in the originally presented claims 1-15. Applicants point out that the claims as filed in the original specification are part of the disclosure. The description of the implant structure is therefore sufficient to convey the described function to one of ordinary skill in the art.

Therefore, Applicants submit that a person having skill in the art can fully understand and appreciate the novel and non-obvious features of the recited invention from the description contained in the present specification.

Withdrawal of the rejection of claims 1, 2 and 4-16 under 35 U.S.C. §112, first paragraph, is therefore requested.

Application No.: 09/509,869

Docket No.: 21547-00268-US

***Objections to the Drawings***

The drawings are objected to under 37 CFR 1.83(a) as failing to show multiple conicities and threads. Applicants respectfully traverse.

As discussed above, multiple conicities and threads are fully illustrated by the drawing figures of the present specification. Applicants therefore respectfully request reconsideration and withdrawal of the objections to the drawings.

***Claim Rejection Under 35 U.S.C. § 102***

Claims 11 and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by O'Brien. Applicants respectfully traverse.

By this amendment, claims 11 and 12 have been canceled, rendering this rejection moot.

***Conclusion***

In view of the above, reconsideration and allowance of the application are respectfully solicited.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Application No.: 09/509,869

Docket No.: 21547-00268-US

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21547-00268-US from which the undersigned is authorized to draw.

Dated: July 28, 2004

Respectfully submitted,

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